

Serial No. 10/582,569

Docket No. US040023

**REMARKS**

Request for reconsideration and allowance of all the pending claims are respectfully requested in light of the amendments and following remarks. Claims 1-19 remain pending herein and stand rejected.

Claims 1, 2, 10, 11 and 19 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Huard et al. (USPPA 2004/0259630) in view of Meade (US Pat. No. 7,206,559). Claims 3-8 and 12-17 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Huard in view of Meade, in further view of O'Neil (US 2002/0107027). Claims 9 and 18 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Huard in view of Meade, in further view of Smith (US Pat. No. 6,580,914).

Applicant respectfully disagrees with, and explicitly traverses, the Examiner's reason for rejecting the claims. A claimed invention is prima facie obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

With regard to claim 1, this claim recites:

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1. A method for providing user data pertaining to a user of a mobile terminal (104) to a recommender system (168) of a consumer electronic device (164), the method comprising the steps of:

determining, by the terminal, a current location of the terminal (208, 236, 248), wherein said current location is determined after receiving a initiating signal, said initiating signal being one of a user input and a received signal;

saving, in the terminal, an identifier of the determined location (316, 240, 252), based on a longevity of said terminal in an area proximate said current location; and

informing, by means of the terminal, said recommender system of a consumer electronic device of the determined location (124, 156, 160).

As recited in method claim 1, a terminal determines its current location, and based on a longevity of the terminal in an area proximate the current location saves, in the terminal, an identifier of the determined location. The terminal informs a recommender system of a consumer electronic device of the determined location. Thus as recited in the claim, all of the above described activities are performed in the terminal itself. Claim 10 recites a mobile terminal device having corresponding features. Claim 10 has been amended to more clearly recite that the terminal itself contains the structure for performing the functions described. Support for this amendment is found, *inter alia*, in the language of claim 1, and in Fig. 1 and its corresponding description in the specification.

The Office Action relies on Huard as the primary reference against the claimed invention. Huard relates to a method and system for rewarding a user's interest in an activity:

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It comprises identifying a location for the user; determining a period of time during which the user is to maintain interest in the activity; monitoring an interest of the user in the activity for the period of time, at the location; deciding if a prize should be awarded to the user if the user has maintained an interest for the period of time, at the location; and choosing and awarding the prize to the user if the decision is positive; whereby the user can be rewarded for having maintain his interest in the activity. [Abstract]

In the rejection of claim 1, paragraph 4 of the Office Action points to paragraph [0017] of Huard as teaching the feature of "determining, by the terminal, a current location of the terminal." While lines 10-14 of this paragraph recite that "players could also carry portable locators ... which ... could send a location signal to a position receiver, or could be used to enter location information directly in a location apparatus, this teaching of Huard fails to address how this information is subsequently used by the terminal in performing the additional steps of the claimed method.

In particular, the Office Action then relies on [0020] of Huard as teaching the claim feature of "saving, in the terminal, an identifier of the determined location based on a longevity of said terminal in an area proximate said current location." Paragraph [0020] recites:

**An activity monitor, communicating with the locator and the timer, is provided for monitoring an interest of the user in the activity for the period of time, at the location. The activity monitor receives an indication of the period of time from the timer and receives a signal from the locator that a player is located at a particular location, such as a player position at a casino table. During**

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the period of time, the monitor verifies if the same player is located at the location and maintain [sic] his interests in the activity. If the required activity is betting in a casino table game, the monitor receives an indication from the locators and/or from the dealer/employee console as to whether the player is continuously betting or if he has stopped. Depending on the conditions chosen for the monitoring, a player who stops betting in the casino table game but remains at his original location may be eligible to the reward or his participation may be rejected. [emphasis added]

Thus, if the Office Action is to rely on Huard's locator being the mobile terminal of claim 1, then it is faced with the problem that this mobile terminal fails to perform the remaining steps performed by this terminal that are recited in claim 1. By way of further example, Fig. 4 clearly depicts how in Huard the functions performed by the locator and timer are performed at separate locations – and in fact shows how no direct connection exists between these components as the control console 54 is interposed between them.

Still further, Fig. 4 clearly shows how a control console, distinct from the mobile terminal, communicates with the activity monitor which in turn provides to the selector (interpreted by the examiner as claim 1's "recommender system") the information necessary to award prizes. Accordingly, Huard fails to teach the feature of claim 1 that the informing of the recommender system is performed by means of the terminal.

Huard relates to a central location by which various inputs are received and processed to reward prizes to various users based on their (gambling) activities (see for example, paragraph [0023]). While Huard does describe how a mobile terminal may be

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employed in the obtaining of user location information [0017], such a terminal is clearly not involved in the remaining functions of Huard's invention. As such it can be argued that Huard in fact teaches away from the use of the terminal device being used to perform these functions.

Paragraph 4 of the Office Action acknowledges that "Huard fails to explicitly teach that the recommender [sic] being a system of an actual consumer device." Meade is then introduced to teach a mobile device "being used to apply and update user preferences in appliance and consumer devices." Meade discloses a system for controlling an appliance by a mobile computing device by determining an available content for the appliance, selecting the content used by the appliance and applying user preferences to the appliance. Huard relates to providing prizes to gamblers based on their monitored activities. Applicants respectfully submit that the combination of Huard and Meade fail to teach the features of claim 1, to include the recommender system of a consumer electronic device being informed by a mobile terminal of the location of the mobile terminal, said location and duration at that location being determined by the mobile terminal.

Accordingly as an initial matter, applicants submit that the Huard reference fails to teach the elements of the claimed invention, contrary to the assertions of the Office Action. Having shown that the combined device resulting from the teachings of the cited references does not include all the elements of the present invention, Applicant submits that the reasons for the Examiner's rejections of the claims have been overcome and can

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no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

Moreover the combination of Iluard and Meade cannot sustain a §103 obviousness rejection as there is no motivation to combine these teachings. In order to establish a prima facie case of obviousness, generally three basic criteria must be met;

1. there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings;
2. there must be a reasonable expectation of success; and
3. the prior art reference must teach or suggest all the claim limitations. The **teaching or suggestion** to make the claimed combination and the reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure. *In re Vaeck* (citation omitted). (emphasis added).

However, in addressing obviousness determination under 35 USC §103, the Supreme Court in *KSR International v. Teleflex Inc.* (citation omitted) reaffirmed that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." (citation omitted). The Court stated that "it can be important to identify a reason that would have prompted a person ... to combine the elements in the way the claimed new invention does ... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense is already known. (citation omitted). The Court further addressed the standard for obviousness that had been imposed in decisions rendered by the CAFC in that there must

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be some teaching, suggestion or motivation (TSM) to combine the known elements in the same manner set forth in the claims and found that the TSM to combine provides a "helpful hint" in determining whether claimed subject matter is obvious. The Court however stated that the application of the TSM test is not to be applied in a rigid manner. Rather, the Court favored a more expansive view of the sources of evidence that may be considered in determining an apparent reason to combine known elements. Hence, the Court upheld precedent that "when prior art references require a selected combination to render obvious, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability and, thus, the obviousness, of making the combination." Uniroyal Inc. v. Rudkin-Wiley Corp., (citation omitted).

Meade discloses a system for controlling an appliance by a mobile computing device by determining an available content for the appliance, selecting the content used by the appliance and applying user preferences to the appliance. Huard relates to providing prizes to gamblers based on their monitored activities. Huard discloses that one aspect of such monitoring, location determination, may be performed by a remote device (and that the remote device does not perform additional functions such as timing of location duration or additional communication). Such a remote device of limited functionality is clearly distinguishable from the mobile computing device of Meade. Moreover, what "user preferences" are being provided by Huard's terminal? What aspect of Huard relates to an appliance and its preferences as taught by Meade?

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In addressing the obviousness rejection under 35 USC §103, the *KSR* Court did not diminish the requirement of objective evidence of obviousness. Rejections on the grounds of obviousness cannot be sustained by mere conclusory statements as there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.

In this case, the Examiner has selected elements from different prior art references to find elements recited in the claims. However, other than the conclusory statement that it would be obvious to incorporate the teaching of Meade into the teaching of Huard, the Office has failed to provide any objective teaching or motivation to modify the Huard reference to include a time of stay or longevity determination in the mobile device as is recited in the claims.

Accordingly, with regard to the subject matter recited in claims 1 and 10, Applicant respectfully submits that pursuant to an expansive interpretation of the three basic criteria necessary to show obviousness, a *prima facie* case of obviousness has not been set forth because the combination of the cited references has been impermissibly selected using the teachings of the instant application as a blueprint without any suggestion or reason for such combination.

In this case, Applicant believes that with regard to the referred-to claims, the Examiner has impermissibly incorporated the teachings of the present invention in the cited reference to reject the claims. Accordingly, Applicant submits that the reasons for

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the Examiner's rejections of the claims have been overcome and the rejection can no longer be sustained. Applicant respectfully requests reconsideration, withdrawal of the rejection and allowance of the claims.

In view of the foregoing discussion, the Office Action has failed to make out a *prima facie* case of obviousness, instant independent claim 1 is allowable, and the rejection should be withdrawn. Independent claim 10 recites similar features and is deemed patentable for at least the same reasons.

Claims 2-9 and 11-19 are dependent from one of the independent claims discussed above, and are believed allowable for at least the same reasons and any rejections thereof should be withdrawn. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

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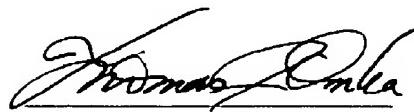
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For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

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